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# TRANSMITTAL OF APPEAL BRIEF (Large Entity)

Docket No.
END920030033US1

In Re Application Of: **Sean E. Aschen et al**

| Application No. | Filing Date | Examiner | Customer No. | Group Art Unit | Confirmation No. |
|---|---|---|---|---|---|
| 10/604,000 | 06/25/2003 | Sangwoo Ahn | 26502 | 2166 | 4746 |

Invention: **MAIL AND CALENDAR TOOL AND METHOD**

COMMISSIONER FOR PATENTS:

Transmitted herewith in triplicate is the Appeal Brief in this application, with respect to the Notice of Appeal filed on

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John Pivnichny
*Signature*

Dated: 08/02/06

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cc: **Records**

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Docket No.: END920030033US1

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In Re Patent Application of: Sean E. Aschen et al

| | | |
|---|---|---|
| Group Art Unit: 2166 | : | IBM Corporation |
| Examiner: Sangwoo Ahn | : | Intellectual Property Law |
| Serial No.: 10/604,000 | : | Department IQ0A/040-3 |
| Filed: 06/25/2003 | : | 1701 North Street |
| Title: MAIL AND CALENDAR TOOL AND METHOD | : | Endicott, New York 13760 |

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on 08/03/06.

Georgia Y. Brundedge 8/3/06

Georgia Y. Brundedge Date

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**APPEAL BRIEF**

Dear Sir:

Appellants hereby appeal from the Final Action of 04/04/2006, and offer the following arguments in support thereof.



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**(i) REAL PARTY IN INTEREST**

The real party in interest is International Business Machines Corporation, a corporation of New York, with a place of business at Armonk, NY 10504.

**(ii) RELATED APPEALS AND INTERFERENCES**

There are no related appeals or interferences with which the undersigned is aware.

**(iii) STATUS OF CLAIMS**

Claims 1 - 20 are pending in the present application. Claims 1 - 20 have all been finally rejected and are the subject matter of this appeal.

**(iv) STATUS OF AMENDMENTS**

There were no amendments filed subsequent to the final rejection of 04/04/2006.

**(v) SUMMARY OF CLAIMED SUBJECT MATTER**

Appellants' invention relates to a unique method, system, computer system and computer program product for providing mailfile data stored on a server to an application running on a user workstation different from this server.

According to Appellants' independent claim 1, data from a mailfile stored on a server is provided to an application (Specification page 5, lines 7 - 16, and FIG. 1, item 12). The mailfile has documents having a section and fields (page 5, line 16 - page 6, line 7). A request is received from an application running on a user workstation different from the server, for one of the documents (page 6, lines 8 - 15). The fields of the document are retrieved from the mailfile and in response to the fields, the document is retrieved as a markup language document (page 6, lines 25 - 28).

A URL is inserted into the markup language document to retrieve the section of one of the documents. The section is retrieved from the mailfile in the markup language (page 7, lines 6 - 14). The URL is removed from the retrieved document at the server and an object is created, having the section expanded in the retrieved document (page 7, line 19 - page 8, line 2). The object is then sent to the application (page 8, line 9 - 12).

Independent claim 10 further requires the files retrieved from the mailfile be text files and binary data.

Independent claim 16 is to a system for performing the steps of claim 1.

Independent claim 19 is to a computer program product on a computer readable medium for performing the steps of claim 1.

**(vi) GROUNDS OF REJECTION**

There are two grounds of rejection. Claims 10 - 15 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Publication Number 2002/0091782 issued to Benninghoff.

Claims 1 - 9 and 16 - 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benninghoff in view of U.S. Patent 5,913,033 issued to Grout.

Specifically, regarding claim 10, the Examiner cites Benninghoff, Figures 1 - 3, 5, 7, 11, 12, 19, and paragraphs 10 - 12, 14, 43, 46, 55, 131, and 134 as disclosing all of the elements of claim 10.

With respect to claim 1, the same parts of Benninghoff are cited as disclosing all of the steps except the inserting, retrieving, and removing steps. The Examiner cites Grout Figures 1A - 1B, 2A - 2B, and column 3, lines 13 - 32, column 5, lines 45 - 61, column 6, line 60 - column 7, line 38, as disclosing these steps.

Independent claims 16 and 19 are rejected for the same reasons as claim 1.

Further detail is not needed because Appellant argues below that all of the independent claims from which the dependent claims depend, are allowable, and therefore all of the dependent

claims rejected under this ground of rejection are also allowable.

**(vii) ARGUMENT**

Claims 10 - 15 are patentable under 35 U.S.C. 102(b) over the prior art and particularly U.S. Patent Publication 2002/0091782 issued to Benninghoff.

Benninghoff does not describe all of the required elements of Appellants' claim 10. Appellants therefore respectfully disagree with this rejection and offer the following arguments in support thereof.

Claim 10 clearly requires a mailfile stored on a server, having data stored as documents with sections. A section is defined in Appellants' Specification page 5, lines 18 - 25. Specifically, a section is defined as additional data which may be hidden or visible when the document is viewed. The Examiner cites Benninghoff Figure 1, element 10, and Figures 1 - 3, 7, and paragraphs 12, 134. Although server 100 is shown as having e-mail capability, no mailfile is shown in Figures 1 - 3 and 7. One can assume that there must be a mailfile on server 100 if it has the e-mail capability shown. There is no description of a mailfile in paragraphs 12 or 134.

There is certainly no description or suggestion of a mailfile stored on a server, having data stored as documents having sections. In fact, there is no mention of anything

related to sections, twistees, or any type of expansion controls in the cited portions of Benninghoff.

The sections feature of claim 10 is simply not described in Benninghoff. The Examiner's citation is in error regarding this feature.

Claim 10 also clearly requires mail and calendaring web service software running on a server different from the workstation for receiving the request from the application for a document, which accesses binary data from the mailfile (which has to be on the server) and creating an object comprising the converted document with the binary data inserted. The Examiner cites Benninghoff Figures 5, 11, and paragraphs 10 - 12, and 134. Recall that server 100 of Figure 1 has web and e-mail capability. There is no description or suggestion of calendaring web service software. Nor is there any description of software on the server for creating an object comprising the converted document with the binary data inserted. The citation given by the Examiner is in error in that no software for creating an object comprising the converted document with the binary data inserted, is described in the citation.

For the above reasons, Benninghoff does not describe all of the elements of claim 10. Independent claim 10 and claims 11 - 15 which depend therefrom are allowable.

Claims 1 - 9 and 16 - 20 are patentable under 35 U.S.C. 103(a) over the prior art and particularly, U.S. Patent

Publication 2002/0091782 issued to Benninghoff in view of U.S. Patent 5,913,033 issued to Grout. The combination of Benninghoff and Grout does not describe all of the steps of Appellants' independent claim 1.

Claim 1 clearly requires that a document be retrieved in response to the fields which are retrieved from the mailfile stored on the server, in response to the request received for the document which has a section. The server has to insert a URL into the document to retrieve the section.

The Examiner cites Benninghoff Figures 2 - 3, 7, and paragraph 12, 134, as disclosing documents having a section and fields. However, as argued above, Benninghoff does not describe sections. This citation is in error.

Claim 1 also requires that the server retrieve the section from the mailfile and create an object having the section expanded in the retrieved document, and the server removes the URL from the retrieved document.

The Examiner admits on page 4, last line - page 5, line 4, of Office Action dated 04/04/2006, that Benninghoff does not describe the retrieving and removing steps of claim 1, but asserts that Grout discloses these important steps. Appellants disagree.

Grout does not describe a server performing these important steps of retrieving a section, and creating an object having the

section expanded in the document. Grout clearly describes in column 1, lines 1 - 46, a client browser requesting a document by its URL, receiving the document which may itself have embedded URL's linking to objects, and the client browser, not the server, downloading the linked objects for presentation. FIG. 2A merely shows a document having linked objects at a client computer. Some of the linked objects are stored on the client computer so that the client browser does not have to request these from a server over a network, thus reducing network traffic. However, there is no description in FIG. 2A of the important steps just mentioned which must be performed by the server in Appellants' claim 1. The Examiner states that the server can by any computer. Appellants disagree. The server in claim 1 must be the server on which the mailfile is stored, must be different from the user workstation, and must be the same server that inserts and removes the URL in the retrieved document.

The Examiner cites Grout FIGs. 2A - 2B and column 5, lines 45 - 61, column 6, line 60 - column 7, line 38, as showing the step of creating an object having the section expanded in the retrieved document. This citation is in error. The step is not shown as being performed by the server.

Appellants, independent claims 16 and 19 are patentable with the same argument as applied to claim 1.

Appellants' position therefore is that rejection of all of the pending claims is in error and must be withdrawn. In view of the above, Appellants respectfully request that the Board

reverse the Examiner's final rejection of all of the claims on appeal, and allow these claims.

Respectfully submitted,

Dated: 08/02/06 By: John Pivnichny

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**(viii) CLAIMS APPENDIX**

1. A method of providing data to an application, comprising the steps of:

providing a mailfile stored on a server, of documents having a section and fields;

receiving a request from an application running on a user workstation different from said server, for one of said documents;

retrieving said fields of said one of said documents from said mailfile;

in response to said fields, retrieving said one of said documents as a markup language document;

inserting at said server, a URL into said markup language document to retrieve said section of said one of said documents;

retrieving at said server, said section from said mailfile in said markup language;

removing at said server, said URL from the retrieved document and creating an object having said section expanded in the retrieved document; and

sending said object to said application.

2. The method of claim 1, wherein said fields are retrieved as an XML document.

3. The method of claim 1, wherein said markup language is HTML.

4. The method of claim 1, wherein said one of said documents has a file attachment link.

5. The method of claim 4, further comprising the steps of retrieving said attachment, removing said link, and inserting said attachment into said object.

6. The method of claim 1, wherein said one of said documents has an image tag.

7. The method of claim 6, further comprising the steps of retrieving the image of said image tag, encoding said image, and inserting the encoded image in place of said image tag in the retrieved document.

8. The method of claim 1, wherein said one of said documents has a link to other items in said document.

9. The method of claim 8, further comprising the steps of retrieving the content of said link, and inserting said content in the retrieved document at the position of said link.

10. A system for providing data stored in a mailfile to an application, comprising:

a mailfile stored on a server, having data stored as documents with sections;

a database for passing a request from an application running on a user workstation, for one of said documents to said mailfile and upon return of said one of said documents, converting said one of said documents into an extended markup format;

an authentication directory having authentication records for an application; and

mail and calendaring web service software running on a server different from said workstation, for receiving said request from said application for a document, receiving text files in an extended markup format from said database, accessing binary data from said mailfile, creating an object comprising the converted document with said binary data inserted, authenticating said application using said directory, and sending said object to said application.

11. The system of claim 10, wherein said database and said software run on different servers.

12. The system of claim 10, wherein said extended markup format is XML.

13. The system of claim 10, wherein said software is adapted to operate without the need of a mail or calendaring client.

14. The system of claim 10, wherein said software is adapted to retrieve said sections of said document from said mailfile.

15. The system of claim 10, wherein said binary data is an image file.

16. A computer system for exposing a mail and calendaring document to an application, said system comprising:

means for storing on a server, mail and calendaring documents having a section and fields, in a mailfile;

means for receiving a request from an application running on a user workstation, for one of said documents;

means for retrieving said fields of said one of said documents

form said mailfile as an extended markup language document;

inserting at said server, a URL into said extended markup language document to retrieve said section of said one of said documents;

retrieving at said server, said section from said mailfile in a second markup language;

removing at said server, said URL from the retrieved document and creating an object having said section expanded in the retrieved document; and

sending said object to said application.

17. The computer system of claim 16, wherein said extended markup language is XML.

18. The computer system of claim 17, wherein said second markup language is HTML.

19. A computer program product for instructing a processor to provide mail and calendaring data to an application, said computer program product comprising:

a computer readable medium;

first program instruction means for retrieving fields in an extended markup language, of a document having a section, in a mailfile stored on a server, in response to a request from an application running on a user workstation;

second program instruction means for inserting at said server, a URL into said document to retrieve said section of said document;

third program instruction means for retrieving at said server, said section from said mailfile in a second markup language;

fourth program instruction means for removing at said server, said URL from the retrieved document and creating an object having said section expanded in the retrieved document; and

fifth program instruction means for sending said object to said application; and wherein

all said program instruction means are recorded on said medium.

20. The computer program product of claim 19, wherein said extended markup language is XML.

**(ix) EVIDENCE APPENDIX**

None.

**(x) RELATED PROCEEDINGS APPENDIX**

None.